

REMARKS

The present application was filed on May 15, 2001 with claims 1-22. Claims 1, 7, 9, 12, 16, 18 and 20-22 are the independent claims. In the outstanding Office Action, the Examiner: (i) rejected claims 9-11, 16, 17 and 20-22 under 35 U.S.C. §101 as being directed to non-statutory subject matter; (ii) rejected claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,102,406 to Miles et al. (hereinafter "Miles") in view of WO 00/41067 to Kay (hereinafter "Kay").

Regarding the rejection of claims 9-11, 16, 17 and 20-22 under 35 U.S.C. §101, Applicants have previously amended independent claims 9, 16 and 20-22 in accordance with the Examiner's suggestions to more clearly recite statutory subject matter, and more specifically, to recite that the limitations are performed on a computer. However, the Examiner has maintained the non-statutory subject matter rejection due to "software per se." Applicants assert that the Examiner has failed to adequately explain how one would arrive at a conclusion of "software per se" for these claims, and further why software would be considered non-statutory subject matter.

Independent claim 9 recites a computer-based user guidance system comprising a server. The server comprises an object manager, a position information generator and a processor, clearly indicating that the steps performed by these elements are performed by a computer. Independent claim 16 recites an object control system of a computer system comprising an object and an object management means, clearly indicating that any steps performed by these elements are performed by a computer. Independent claim 20 recites an object that is functional to be stored at a web site on a network, to move from a predetermined web page to another web page and to be selected by a user, clearly indicating functionality of the object. Independent claim 21 recites a storage medium on which input means of a computer stores a program in an input-enabled form, and independent claim 22 recites a program transmission apparatus comprising a storage means, both clearly reciting tangible embodiments.

While it appears clear that independent claims 9, 16, 21 and 22 are not directed to "software per se," Applicants assert that a claim directed to software does not in itself constitute non-statutory subject matter. It is well-established law that an invention directed toward techniques that may be

implemented in one or more processing devices is proper statutory subject matter under §101 if it produces a useful, concrete and tangible result. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). In fact, the Federal Circuit in *State Street* goes on to state that subject matter is rendered statutory even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss. Thus, Applicants believe that claims 9-11, 16, 17 and 20-22 contain statutory subject matter under §101 and therefore request withdrawal of the rejections under §101.

Regarding the rejection of claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over Miles in view of Kay, Applicants respectfully assert that the cited combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth therein, M.P.E.P. §2143 states that three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that no motivation or suggestion exists to combine Miles and Kay in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a prima facie case of obviousness has not been established.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” *Id* at 1343-1344.

In the Office Action, on page 5, paragraph 1, the Examiner provides the following statement to prove motivation to combine Miles and Kay, with emphasis supplied:

“It would have been obvious . . . to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.”

Applicants submit that the statement above is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is well-settled law that “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Miles and Kay in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner’s conclusory statements do not adequately address the issue of motivation to combine references. “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Secondly, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Miles and Kay. For at least this reason, a *prima facie* case of obviousness has not been established. Applicants do not believe that Miles and Kay are combinable since it is not clear how one would combine them. No guidance was provided in the Office Action as to how the references can be combined to achieve the present invention. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Lastly, the collective teaching of Miles and Kay fails to suggest or render obvious at least the elements of independent claims 1, 7, 9, 12, 16, 18 and 20-22 of the present invention. For at least this reason, a prima facie case of obviousness has not been established.

The present invention, for example, as recited in independent claim 1 recites a user guidance method performed on a computer. An object is incorporated into a specific web site at a specific location. The object is capable of being selected by a user in order to provide a reward for the user. The object is moved from the specific location to a different location, and at least one user desiring to select the object is guided to predetermined content available at the specific web site. Independent claim 7 recites similar limitations.

Miles discloses an Internet-based advertising scheme employing a scavenger hunt metaphor. During the scavenger hunt the user may click on a hyperlink of a web page to return to the scavenger hunt game site in order to answer a specific question regarding the content of the web page. If the user meets specific requirements and answers the question correctly, the user may select a new clue directed to another web page having a hyperlink.

As admitted by the Examiner, Miles fails to disclose the moving of the object as recited in independent claims 1 and 7. Miles contains no description or suggestion that the hyperlink moves. To the contrary, Miles describes embodiments in which many users play the scavenger hunt game at the same time, during which the hyperlinks must remain on the individual web pages so that each player is able to play. Therefore, Miles requires multiple fixed hyperlinks, without the movement recited in claims 1 and 7 of the present invention.

The Examiner refers to Kay in order to remedy the deficiencies described above. Kay discloses a method and device for stimulating a potential customer to purchase goods or services from a web site through the formation of a link on a web page. The link may be implanted or overlaid on a web page at a single location, or at a plurality of locations. However, the description of one or more links on a single web page fails to provide any description or suggestion that the hyperlink moves. Therefore, Kay fails to remedy the deficiencies described above with regard to Miles, and the combination of Miles and Kay also fails to disclose the moving of the object as recited in independent claims 1 and 7.

Independent claim 9 recites a computer-based user guidance system having a server comprising an object manager for managing the location and movement of an object on a network. The server also comprises a position information generator for generating information concerning the location of the object, and for providing the information to a user who is accessing the network. Finally, the server comprises a processor for performing a predetermined process associated with the object selection, when the object is selected by a predetermined user. The object manager arranges the object at a desired location in order to guide the user to desired contents on the network. The combination of Miles and Kay fails to disclose an object manager that manages the location and movement of an object on a network and arranges the object at a desired location to guide the user to the desired content on the network, as described above with regard to claim 1.

Independent claim 12 recites a computer-based object control system comprising web servers for storing web pages. The object control system also comprises a main server for communicating with a predetermined web server. The main server incorporates a specific object into a first specific web page and removes the specific object from a second specific web page stored in the specific web server. The combination of Miles and Kay fails to disclose a main server that incorporates the object into a first web page and removes the object from a second web page.

Independent claim 16 recites an object control system of a computer comprising an object to be embedded in a web page stored at a web site on a network. The object control system also comprises an object management means for managing the location of the object on the network. The object management means changes the location of the object on the network in order to move the object across the network. Again, the combination of Miles and Kay fails to disclose the changing of the location of the object on the network in order to move the object across the network, as described above with regard to claim 1.

Independent claim 18 recites a computer-based object control system comprising an object stored in a predetermined server. The object control system also comprises a link setting means for setting a link in a web page stored at a web site on the network in order to move to the object. Finally, the object control system comprises an object position management means for determining a web page for setting a link thereto. Under the control of the object position management means

the link setting means changes a target web page for setting a link thereto. The combination of Miles and Kay fails to disclose a link setting means for setting a link in a web page to move the object.

Independent claim 20 recites a moving object to be embedded in a web page stored at a web site on a network, which moves from a predetermined web page to another web page and is capable of being selected by a user in order to provide a reward for the user. The location on the network is managed by specific management means. The combination of Miles and Kay fails to disclose an object, capable of being selected by the user in order to provide a reward for the user, which moves from a predetermined web page to another web page, as described above with regard to claim 1.

Independent claim 21 recites a storage medium on which input means of a computer stores a program in an input-enabled form. The program causes the computer to perform a process for incorporating a specific object into a specific web page stored in a specific web server. The program also causes the computer to perform a process for moving the object to another web page when a user browses the specific web page and selects the specific object. Independent claim 22 recites similar limitations to those of claim 21. The combination of Miles and Kay fails to disclose a process for moving the object to another web page when a user browses the specific web page, as described above with regard to claim 1.

Dependent claims 2-6, 8, 10, 11, 13-15, 17 and 19 are patentable at least by virtue of their dependency from independent claims 1, 7, 9, 12, 16 and 18. Dependent claims 2-6, 8, 10, 11, 13-15, 17 and 19 also recite patentable subject matter in their own right. For example, with regard to claim 2, the combination of Miles and Kay fails to disclose the incorporation of the object into the specific web site at a different location after the object has been selected by the user. Further, the combination of Miles and Kay fails to disclose that the information concerning the location of the object, which is provided for the user, indicates the ease with which the object can be reached from the web page browsed by the user, as recited in dependent claim 15. Accordingly, withdrawal of the rejection of claims 1-22 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 1-22 are in condition for allowance, and respectfully request withdrawal of the §101 and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Griffith". The signature is fluid and cursive, with the first name "Robert" and last name "Griffith" being clearly legible.

Date: December 19, 2005

Robert W. Griffith
Attorney for Applicant(s)
Reg. No. 48,956
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-4547